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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/612,094

Applicant(s)

WEISER ET AL.

Examiner

Ernesto Garcia

Art Unit

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*NEJ*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/1/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Restriction*

Applicant's election with traverse of claims 4-11 in the reply filed on November 1, 2004 is acknowledged (note, claim 8 was a typographical error in the restriction requirement and should have been claims 4-9 instead of claims 4-8). The traversal is on the ground(s) that claims 1-16 are drawn to a singular inventive concept as shown in the drawings and set forth in the claims. This is not found persuasive because the applicant was not filed under 35 U.S.C. 371 or the application is not a PCT application where the rule of unity of invention, regarding a singular inventive concept, only applies in these types of applications. Applicant further argued that the restriction requirement is nothing more than an attempt for the examiner to secure an additional patent application filling for but a single invention. It is of little consequence to the examiner whether or not applicants file any additional patent applications. However, what is of concern to the examiner is the serious burden that would be imposed on having to examine (which includes consideration of any remarks that may be provided) multiple patentably distinct inventions in the same application. While applicants continually make reference to a "single invention", it is noted that applicants fail to point out specifically how the restriction requirement is improper. Applicants are required to distinctly and specifically point out the supposed errors. General allegations that the requirement is improper are insufficient.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-3 and 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 1, 2004.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the package (claim 10) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and

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appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because it should avoid using phrases which can be implied, such as, "The disclosure concerns", "The disclosure defined by this invention", "The disclosure describes", "The present invention is", etc. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because on page 7 in line 17 item 25 is referred to as an aperture when 25 is actually being described as a barrier on page 5 in line 14. The discrepancy also occurs on page 6 in lines 20 and 21, and on page 7 in line 2. Appropriate correction is required.

### ***Claim Objections***

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Claims 5-10 are objected to because of the following informalities:

regarding claim 5, "wing-like" in line 2 should be --wing--;

regarding claims 6, 8 and 9, "member" in line 1 should be --structure-- for proper antecedent basis;

regarding claim 7, "member" in line 3 should be --structure-- for proper antecedent basis; and,

regarding claim 10, "unpackaging" in line 6 should be --unpacking--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4 is structurally incomplete. In particular, the connecting member 21, in addition to the connecting structure 10, is critical or essential to the practice of the invention. Note *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 4 states that "the connecting structure secures the appendage to the body" (lines 5-6). However, the connecting structure 10 alone cannot secure the appendage to the body unless the coil spring is cooperating with the connecting structure 10. Therefore, the connecting member 21 is essential to secure the appendage to the body.

Regarding claims 5-7, the claims depend from claim 4 and therefore are indefinite.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the term "relatively low forces" in claim 9 is an undefined relative term, which renders the claim indefinite. The term "low forces" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In other words, what is considered "relatively low" forces, and relative to what are these forces being compared?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell, 6,126,356.

Regarding claim 4, Russell discloses, in Figure 1, a novelty system comprising a body **104**, one appendage **150** or more appendages **150**, and a connecting structure **120**. The body **104** has apertures **114**. The appendage **150** or the appendages **150** correspond to the apertures **114**. The connecting structure **120** secures the appendage **150** or the appendages **150** to the body **104**. The post **132** includes prongs **142** flexibly coupled to a first end **144** of the post **132** and retained therein.

Regarding claim 5, the appendage **150** or the appendages **150** comprises a wing-like structure.

Regarding claim 6, the connecting structure **120** includes a second end **140** configured to connect to the appendage **150** or the appendages **150**.



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Regarding claim 7, the appendage **150** or the appendages **150** comprise an enclosure configured to secure to the second end **140** of the connecting structure **120**.

Claims 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobs, 4,973,212 (see marked-up attachment).

Regarding claim 4, Jacobs discloses, in Figure 1, a novelty system comprising a body **86**, one appendage **88** or more appendages **88**, and a connecting structure **68,100**. The body **86** has apertures **84**. The appendage **88** or the appendages **88** correspond to the apertures **84**. The connecting structure **68,100** secures the appendage **88** or the appendages **88** to the body **86**. The post **A1** includes prongs **A5** flexibly coupled to a first end **A2** of the post **A1** and retained therein.

Regarding claim 5, the appendage **88** or the appendages **88** comprises a wing-like structure.

Regarding claim 6, the connecting structure **68,100** includes a second end **A12** configured to connect to the appendage **88** or the appendages **88**.

Regarding claim 7, the appendage **88** or the appendages **88** comprise an enclosure configured to secure to the second end **A12** of the connecting structure **68,100**.

Regarding claim 8, the connecting structure **68,100** is a coil spring (col. 5, lines 32-37).

Regarding claim 9, the connecting structure **68,100** has a spring constant that allows the appendages **88** to be able to freely move under application of relatively low forces.

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Zobebelein, 3,596,942.

At the outset, it should be noted that in method claims, it is the patentability of the method steps, not the recited structure, that is to be determined. Structure not affected in the manipulation sense is given to patentable weight.

Regarding claim 10, Zobebelein discloses a method of constructing a novelty.

The method comprises

ship, in a package, a body **11** (the novelty);

unpack the novelty (col. 1, lines 10-15); and

secure appendages **14** to the body **11** by operatively connecting structures

**15,40,41** with apertures **43** of the body **11**.

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Regarding claim 11, securing includes inserting the connecting structures **15,40,41** into the apertures **43**.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell, 6,126,356.

At the outset, it should be noted that in method claims, it is the patentability of the method steps, not the recited structure, that is to be determined. Structure not affected in the manipulation sense is given to patentable weight.

Regarding claim 10, Russell discloses a method of constructing a novelty. The method comprises securing appendages **150** to a body **104** by operatively connecting structures **120** with apertures **114** of the body **104**. However, Russell does not disclose shipping, in a package, the body (the novelty) and unpackaging the novelty. Applicant is reminded that shipping and unpacking are secondary steps in delivering the

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invention to a customer whom purchases the invention. The shipper normally ships the invention in a package and upon delivery, the customer will unpack the invention from bubble wrap, popcorn, newspaper, or paper wrap. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ship the novelty in a package and unpack the novelty as part of a delivery process.

Regarding claim 11, securing includes inserting the connecting structures **120** into the apertures **114**.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Butterbaugh et al. show a similar novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a

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general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*E.G.*

*Daniel P. Stodola*

E.G.

December 23, 2004

Attachment: one marked-up page of Jacobs, 4,973,212.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

